

REMARKS/ARGUMENTS

Claims 14, 16, 17, 19 and 22 are pending in the present application. Claims 1-13, 15, 18, 20, 21 and 23-27 have been previously cancelled. Reconsideration of the claims is respectfully requested.

I. 35 U.S.C. §112, Second Paragraph

Claim 14 stands rejected under 35 U.S.C. §112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter, which applicants regard as the invention. This rejection is respectfully traversed.

In rejecting Claim 14 under 35 U.S.C. §112, second paragraph, the Examiner states that such claim is incomplete for omitting essential steps – with the omitted step being “sharing text in the electronic book’ – pursuant to MPEP 2172.01. Applicants urge error in such rejection, as this section of the MPEP states:

“A claim which omits matter disclosed to be essential to the invention as described in the specification or in other statements of record may be rejected under 35 U.S.C. 112, first paragraph, as not enabling. *In re Mayhew*, 527 F.2d 1229, 188 USPQ 356 (CCPA 1976).”

“In addition, a claim which fails to interrelate essential elements of the invention as defined by applicant(s) in the specification may be rejected under 35 U.S.C. 112, second paragraph, for failure to point out and distinctly claim the invention.”

As can be seen, a claim which *omits matter to be essential* may be rejected under 35 USC §112, first paragraph, whereas a claim which fails to *interrelate essential elements* of the invention as defined by Applicants in the specification may be rejected under 35 USC §112, second paragraph. It is error to reject Claim 14 under 35 USC §112, second paragraph as *omitting essential steps*.

Further, the essential step alleged by the Examiner to be omitted from Claim 14 (‘sharing text in the electronic book’) it explicitly and expressly recited in Claim 14 (‘A method in a data processing system for *sharing text in an electronic book*’). Thus, it is further urged that Claim 14 has been erroneously rejected as the alleged omitted essential element is in fact explicitly recited in Claim 14.

Still further, the steps of (i) receiving selected text from at least one remote electronic book through a communications link to the data processing system, wherein the selected text includes passages from the at least one remote electronic book; (ii) sorting the selected text from the at least one remote electronic book using a selection criteria; (iii) displaying the sorted text; and (iv) highlighting portions of the electronic book based on the user input, *wherein the highlighted portions of the electronic book correspond to the selected text received from that at least one remote electronic book* interrelate together

to provide sharing of text in an electronic book (e.g. a data processing system receives and processes (sorts; displays; highlights) text from a remote electronic book, and thus the text is shared).

Therefore the rejection of Claim 14 under 35 U.S.C. §112, second paragraph has been overcome.

II. 35 U.S.C. §103, Obviousness

Claims 14, 16-17, 19 and 22 stand rejected under 35 U.S.C. §103 as being unpatentable over Patent No. US 6,457,026 B1 issued to *Graham et al.* (hereinafter “*Graham*”) in view of Patent No. US 6,697,999 B1 issued to *Breuer et al.* (hereinafter “*Breuer*”). This rejection is respectfully traversed.

With respect to Claim 14, such claim explicitly recites steps of “receiving selected text from at least one remote electronic book through a communications link to the data processing system, wherein the selected text includes passages from the at least one remote electronic book”. As can be seen, selected text is received from a remote electronic book through a communication link. In addition, Claim 14 recites “responsive to a user input, *sorting* the selected text from the at least one remote electronic book *using a selection criteria* to form sorted text, *wherein the selection criteria is received with the selected text*”. These claimed features advantageously provide ease of text collaboration/sharing, by allowing for receiving *both* (i) selected text, and (ii) selection criteria which is used to sort the selected text. In rejecting Claim 14, the Examiner acknowledges that the cited *Graham* reference does not teach or suggest ‘sorting the selected text from the at least one remote electronic book using selection criteria to form sorted text’, but states that the cited *Breuer* reference teaches this claimed step since *Breuer* teaches transmitting the portion of the selected text from one PDA machine to a remote machine over Internet network (citing fig. 2A and col. 6, lines 66-67 and col. 7, lines 1-8) and displaying the sorted text in an alphabetical order (citing col. 8, lines 10-48). Notably absent from such assertion is any allegation that the cited *Breuer* reference teaches ‘responsive to a user input, sorting the selected text from the at least one remote electronic book using a selection criteria to form sorted text, *wherein the selection criteria is received with the selected text*’. Thus, the Examiner has failed to establish a *prima facie* showing of obviousness with respect to Claim 14¹. Accordingly, the burden has not shifted to Applicants to rebut this obviousness assertion due to such failure by the Examiner to properly establish a *prima facie* showing of obviousness². In addition, Claim 14 has been erroneously rejected due to such failure by the Examiner to properly establish a *prima facie* showing of obviousness³.

¹ To establish *prima facie* obviousness of a claimed invention, all of the claim limitations must be taught or suggested by the prior art. MPEP 2143.03. *See also, In re Royka*, 490 F.2d 580 (C.C.P.A. 1974) (emphasis added by Applicants).

² In rejecting claims under 35 U.S.C. Section 103, the examiner bears the initial burden of presenting a *prima facie* case of obviousness. *In re Oetiker*, 977 F.2d 1443, 1445, 24 USPQ2d 1443, 1444 (Fed. Cir.

Further with respect to Claim 14, the *Breuer* passage cited as teaching sorting of selected text in fact teaches sorting of *formatting actions that were performed as a part of the automatic formatting*. Such sorting of *actions* by the name of the action does not teach or otherwise suggest sorting the *selected text from the at least one remote electronic book*. Thus, it is further urged that a proper *prima facie* showing of obviousness has not been established with respect to Claim 14.

Applicants traverse the rejection of Claims 16, 17, 19 and 22 for similar reasons to those given above with respect to the 35 U.S.C. §103 rejection of Claim 14.

Therefore, the rejection of Claims 14, 16-17, 19 and 22 under 35 U.S.C. §103 has been overcome.

III. Conclusion

It is respectfully urged that the subject application is patentable over the cited references and is now in condition for allowance. The Examiner is invited to call the undersigned at the below-listed telephone number if in the opinion of the Examiner such a telephone conference would expedite or aid the prosecution and examination of this application.

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Respectfully submitted,

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1992). *Only if that burden is met*, does the burden of coming forward with evidence or argument shift to the applicant. *Id.* (emphasis added by Applicants).

³ If the examiner fails to establish a *prima facie* case, *the rejection is improper* and will be overturned. *In re Fine*, 837 F.2d 1071, 1074, 5 USPQ2d 1596, 1598 (Fed. Cir. 1988) (emphasis added by Applicants).